



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/891,301	07/10/1997	KENNETH HARRENSTIEN	224/183	5720
23639	7590	01/09/2004		
BINGHAM, MCCUTCHEN LLP THREE EMBARCADERO, SUITE 1800 SAN FRANCISCO, CA 94111-4067			EXAMINER TRAN, PABLO N	
			ART UNIT	PAPER NUMBER
			2685	
			DATE MAILED: 01/09/2004	

37

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/891,301

Applicant(s)

HARRENSTIEN ET AL.

Examiner

Pablo N Tran

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-100 is/are pending in the application.
- 4a) Of the above claim(s) 1-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Remarks

1. Since the instant Application is a CIP of US Application Serial No. 08/521,660, now US patent No. 5,850,517, therefore the newly subject matters of the instant Application are entitled to the filing date of 07/10/97.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 57, 65, 84, and 92 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Regarding claims 57, 65, 84, and 92, the claimed limitation "the data notification is evaluated at the client station" render the claim indefinite. The data notification is transmitted to the transceiver, the transceiver being separated from the client station, therefore how can the user evaluated the notification at the client station? Appropriated correction required.

Claim Rejections - 35 USC § 103

Art Unit: 2685

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 47-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Eggleston et al.* (5,958,006) in view of *Powell et al.* (WO9114332A1).

As per claims 47 and 74, *Anderson et al.* disclosed a method of transmitting information from a server to a client station wherein determining whether the server has information for the client station without the client station requesting the info and generating a data notification in response to the server having info for the client station (abstract).

Eggleston et al. disclosed a separated transceiver but do not specifically disclosed transmitting the data notification to the transceiver. However, such unsolicited info (e.g., data alerts) transmitted to a separated transceiver is well known in the art, as taught by *Powell et al.* (pg. 7/ln. 35-pg. 8/ln. 21). Therefore, such method of providing unsolicited info (e.g., data alerts) transmitted to a separated transceiver, as taught by *Powell et al.*, to the communication system of *Eggleston et al.* thus allows the user to defer answering the message and the user is offered an increased level of convenience.

As per claims 48-50, 60, 68, 75-77, 87, and 95, the modified system of *Eggleston et al.* further disclosed connecting the client station to the transceiver to establish connection with server (see *Eggleston et al.*, fig. 1).

As per claims 51 and 78, the modified system of *Eggleston et al.* further disclosed the client station could establish a log-on connection with the server based on the telephonic address (see *Eggleston et al.*, col. 3/ln. 35-56, col. 12/ln. 7-28, col. 13/ln. 22-55, see *Powell et al.*, pg. 7/ln. 35-pg. 8/ln. 21).

As per claims 52-53 and 79-80, the modified system of *Eggleston et al.* further disclosed transmitting a first request for the info, receiving the info, and transmitting further request for info (see *Eggleston et al.*, abstract, col. 2/ln. 66-col. 4/ln. 3).

As per claims 54-55, 58, 62-63, 66, 72-73, 81-82, 85, 89-90, 93, and 99-100, the modified system of *Eggleston et al.* further disclosed such generated summary of type and quantity of information (see *Eggleston et al.*, abstract, fig. 3-4, col. 2/ln. 66-col. 4/ln. 3).

As per claims 56, 64, 83, and 91, the modified system of *Eggleston et al.* further disclosed the data notification is evaluated at the transceiver (see *Powell et al.*, pg. 7/ln. 35-pg. 8/ln. 21).

As per claims 59, 61, 67, 69, 86, 88, 94, and 96, the modified system of *Eggleston et al.* further disclosed relaying the notification from the transceiver to the client station (see *Eggleston et al.*, abstract, col. 2/ln. 66-col. 4/ln. 3, see *Powell et al.*, pg. 7/ln. 35-pg. 8/ln. 21).

As per claims 70-71 and 97-98, the modified system of *Eggleston et al.* further disclosed transmitting the message between GSM based transceivers (see *Eggleston et al.*, col. 4/ln. 35).

Art Unit: 2685

The modified system of *Eggleston et al.* does not disclosed transmitting the message in an SMS paging message format. However, such is notoriously well known in the art the Examiner takes official notice of such. Therefore, it would have been obvious to one of ordinary skill in the art at the time to provide the method of SMS paging message, well known in the art, to the modified system of *Eggleston et al.* in order to save time and tariff charge.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kita (5,960,367), Yamashita (5,848,362), Stein (5,628,055), Willard et al. (4,803,487), and Sato (EP0746131A1) disclose radiotelephone communication system.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo Tran whose telephone number is (703)308-7941. The examiner normal hours are 9:30 -5:00 (Monday-Friday). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (703)305-4385.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

9. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

PABLO N. TRAN
PRIMARY EXAMINER

January 7, 2004


2685